

REMARKS

Claim Amendments

Claims 1-3 and 11-14 have been amended to delete a repeated phrase that was inadvertently included. No new matter has been added. Entry of the amendment is appropriate under 37 C.F.R. § 1.116 and is respectfully requested.

Rejection of claims under 35 U.S.C. § 103(a)

Claims 1-3, 5, 9, 10, 12-14, 16, 20, and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,135,120 to Lofman (“Lofman”) in view of U.S. Patent 4,606,357 to Dusek et al. (“Dusek”). Applicant respectfully traverses the rejection.

The U.S. Patent and Trademark Office bears the initial burden of establishing a *prima facie* case of obviousness. The *prima facie* case requires three showings:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

Manual of Patent Examining Procedure, 8th ed., § 2142 (emphasis added). The Patent Office has not made a *prima facie* case of obviousness at least because the prior art references, even if combined, do not teach or suggest all of the claim limitations.

Independent claim 1 recites, *inter alia*, a smokeless tobacco product comprising a solid bit of powdered tobacco and from about 0.5 to about 15 wt% peppermint, from about 0.5 to about 15 wt% menthol, and from about 0.5 to about 15 wt% wintergreen. Independent claim 12

recites, *inter alia*, a smokeless tobacco product comprising a solid bit of powdered tobacco and from about 0.5 to about 15 wt% peppermint, from about 0.5 to about 15 wt% menthol, and from about 0.5 to about 15 wt% spearmint.

The Office Action cites Lofman as disclosing “compressed snuff portions (corresponding to the claimed ‘solid bit of powdered tobacco’).” Office Action at page 2, lines 17-18. The Office Action concedes that Lofman does not describe tobacco material containing peppermint, menthol, wintergreen, and/or spearmint flavorants.

Dusek is cited as describing a tobacco composition containing finely cut tobacco or fine grade snuff (column 4, lines 18-20). According to Dusek, the composition may include flavors such as essential oils such as peppermint oil, spearmint oil, oil of wintergreen, or mixtures thereof (column 4, lines 63-66).

Neither Lofman nor Dusek describes a tobacco product containing menthol at any concentration. Therefore, the combination of Lofman and Dusek fails to describe or suggest the invention of independent claims 1 and 12 for at least this reason. The Patent Office has failed to make a *prima facie* case of obviousness because the prior art references, when combined, do not teach or suggest all the claim limitations. Dependent claims 2, 3, 5, 9, 10, 13, 14, 16, 20, and 21 are allowable for at least the same reasons applicable to independent claims 1 and 12.

Claims 6-8 and 17-19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lofman in view of Dusek and further in view of WO 00/15056 to Williams (“Williams”). Applicant respectfully traverses the rejection.

Williams is cited as describing tobacco products having very low levels of tobacco-specific nitrosamines. Office Action at page 3. Williams does not describe a smokeless tobacco product comprising a solid bit of powdered tobacco or any peppermint, menthol, wintergreen,

and/or spearmint flavorants. Williams thus fails to remedy the deficiencies of the primary references as discussed above. Dependent claims 6-8 and 17-19 are allowable over the prior art for at least the same reasons as are applicable to independent claims 1 and 12.

None of the prior art references, taken alone or when combined, teach or suggest all the claim limitations. Therefore, the Patent Office has failed to establish a *prima facie* case of obviousness.

Reconsideration and withdrawal of each of the prior art rejections are respectfully requested. The Examiner is invited to telephone the undersigned at the number listed below if doing so would be helpful to resolve any outstanding issues.

Respectfully submitted,

BANNER & WITCOFF, LTD.

Date: May 17, 2007

By: /Paul M. Rivard/

Customer No. 22907

Paul M. Rivard

Registration No. 43,446

1100 13th Street, N.W.
Suite 1200
Washington, DC 20005-4051
(202) 824-3000 (telephone)
(202) 824-3001 (facsimile)